

CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10)Applicant(s): **Ronald J. Hammond**

Docket No.

0028019.00201

Application No.

10/662,134

Filing Date

September 12, 2003

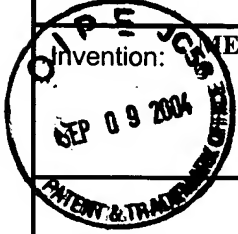
Examiner

George R. Koch, III

Customer No.

21878

Group Art Unit

1734Invention: **METHOD OF MAKING A COMPOSITE CARTON**

I hereby certify that the following correspondence:

Response to Office Action*(Identify type of correspondence)*

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

September 9, 2004*(Date)*Janet L. Babaa*(Typed or Printed Name of Person Mailing Correspondence)*

A handwritten signature in dark ink, appearing to read "Janet L. Babaa".

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9-10-04

EFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent Application of:)	
)	Attorney Docket No. 0028019.00201
)	
Ronald J. Hammond)	Patent Examiner: George R. Koch III
Serial No.: 10/662,134)	
Filed: September 12, 2003)	Group Art Unit: 1734
For: METHOD OF MAKING A)	
<u>COMPOSITE CARTON</u>)	Confirmation No. 9078

Charlotte, North Carolina
September 9, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO OFFICE ACTION

Sir:

This paper is submitted in response to the Office Action mailed on August 12, 2004. In the Office Action, the claimed invention has been categorized into species represented within four groups and Applicant has been required under 35 U.S.C. § 121 to elect a single species *from each group* for prosecution on the merits. Applicant respectfully traverses the election requirement and requests reconsideration and withdrawal thereof in light of the discussion below.

In order for an election requirement to be proper, it must be shown that: (1) inventions claimed in an application are independent or distinct; and (2) there must be a serious burden on the examiner if all of the claims are prosecuted. M.P.E.P. § 803. "[I]f the search and examination of an entire application can be made without serious burden, the examiner must

examine it on the merits, even though it includes claims to independent or distinct inventions.”

M.P.E.P. § 803.

In order to establish a *prima facie* serious burden in order to support an election requirement, one of the following must be shown:

- separate classification of the claimed species;
- separate status in the art of the species when they are classifiable together; or
- a different field of search required for the species.

M.P.E.P. §§ 803 and 808.02. Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions. M.P.E.P. § 808.02.

Applicant notes that the Office Action does not contain any of the required showings. Accordingly, Applicant respectfully submits that the Office Action has not established a *prima facie* case of serious burden and thus the election requirement is not proper.

In addition, it is respectfully submitted that a search for any of the identified species will necessarily entail a search for the subject matter of the other species. Thus, a simultaneous search for all claims is believed not to constitute an unreasonable search for the Patent Office.

While Applicant believes that all of the claims in this application should be examined together for the reasons stated above, Applicant nonetheless recognizes that a provisional election among the identified species must be made in this Response in order for the Response to be deemed complete. Accordingly, without waiving the request for reconsideration for the reasons set forth above, Applicant hereby provisionally elects with traverse to prosecute in this application the following species from each listed Group:



Group	Elected Species	Claims Reading on Elected Species
1	a.	9, 20-36
2	e.	14
3	f.	16, 35
4	i.	30, 31

Receipt of a further action on the merits is awaited. Should there be any questions regarding this application, the Examiner is invited to contact the undersigned at the telephone number shown below.

Respectfully submitted,

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Typed Name: Janet L. Babaa

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